

REMARKS

The Office Action of July 1, 2008 has been received and its contents carefully considered.

Summary of Claim Amendments:

The present Amendment revises the independent claims by adding “a speech output unit to announce, in plain speech, that the designated user has an incoming call if the designated user is available to answer the call, the announcement identifying the designated user by name.” This is supported (for example) by the flow chart shown in Figure 3 of the application’s drawings and by the paragraph at page 7, lines 5-24. The Amendment also adds a new independent claim 20, which is similar to claim 9 as originally presented (that is, claim 20 does not include the speech output unit that has been added to claim 9), except the preamble of claim 20 recites a “communication terminal for use by a plurality of users, the communication terminal being connected to a single communication line.” New dependent claims 21-23 are similar to claims 10-12. New dependent claim 24 recites a speech output unit, and also a housing for the memory, processor, and speech output unit. While the specification of this application does not specifically mention a housing, an ordinarily skilled person would have realized from Figure 1 (for example) that the inventor was in mental possession of a housing for the memory, processor, and speech output unit.

The present Amendment also revises the claims to make improvements of a formal nature. These improvements include revisions to claims 18 and 19 in response to the rejection in section 6 of the Office Action. It is respectfully submitted that claims 18 and 19 are now suitably definite under the second paragraph of 37 USC 112.

Foreign Priority:

Sections 2 and 3 of the Office Action assert that this application is not entitled to the benefit of priority of Japanese application 2001-363670, filed on November 29, 2001. Applicant respectfully disagrees. A certified copy of the priority application was filed in the parent of the present application (the parent application was number 10/107,165, filed March 28, 2002, and subsequently issued on August 3, 2004 as patent 6,771,747) on March 28, 2002. As evidence that it was indeed filed, a copy of our filing receipt for the

parent application is attached. Among the papers filed, the postcard lists "PRIORITY DOCUMENT' 670." The Attached copy of the postcard bears the Patent and Trademark's Office date stamp for March 28, 2002, thus verifying that the priority document was indeed filed.

There is further evidence that the priority document was properly filed in the parent application, since the cover page of patent 6,771,747 identifies foreign application priority data. The priority application would not have been identified in the issued patent unless a certified copy was physically present, at some point, at the Patent and Trademark Office. Section 2 of the Office Action comments that the certified copy cannot be found, but whatever mishap caused this problem, it is not the fault of the Applicant.

Section 2 of the Office Action also comments that the parent application number 10/107,165 is a divisional application. The Applicant respectfully disagrees. There was no claim under 35 USC 120 in the parent application to the benefit of the filing date of an earlier US application. This can be confirmed by inspecting the coversheet of patent 6,771,747, and also noting the absence of a cross-reference to any earlier US application in column 1 of the specification.

It is noted that a Preliminary Amendment that was filed along with the present application designated the present application a "divisional" of the parent application. It is believed to be more accurate to call it a "continuation" application, and this correction is made in the present Amendment. The correction also notes the Japanese priority application.

Section 3 of the Office Action comments that a claim for priority cannot be made since the US application was filed more than twelve months after the Japanese application. However, the present application was filed while the parent application was pending at the Patent and Trademark Office, and includes (in the Preliminary Amendment) a claim under 35 USC 120 to the benefit of the parent application. The effective US filing date of the present application is therefore March 28, 2002, less than a year from the filing date of the Japanese priority application.

In summary, it is respectfully submitted that the present application is entitled to priority and the requirements for claiming priority have been fulfilled, regardless of what might have happened to the certified copy after it was filed.

The Information Disclosure Statement:

Section 4 of the Office Action alleges that an Information Disclosure Statement that was filed along with the present application fails to comply with 37 CFR 1.98 (a) (2). Nevertheless, the Information Disclosure Statement complied with 37 CFR 1.98 (d).

Section 4 of the Office Action also comments that it was improper to submit a previously signed form PTO-1449. Applicant respectfully disagrees. The Information Disclosure Statement would not comply with 37 CFR 1.98 (a)(1) if it were filed today, but it was filed back in 2004. At the time, 37 CFR 1.98 (a)(1) only required "A list of all patents, publications, applications, or other information submitted for consideration by the Office". It is respectfully submitted that the forms submitted provided such a "list," so the Information Disclosure Statement adequately complied with 37 CFR 1.98 at the time it was filed.

Nevertheless, section 4 of the Office Action advises that the three foreign references cannot be found, so copies are attached. Patent Abstracts of Japan summaries are also attached to provide English-language information about the relevance of these references. Finally, a Form PTO-1449, listing the references is attached for the Examiner's convenience.

A fee is not believed to be needed, even though the time period identified in 37 CFR 1.97 (b) has passed, since the original Information Disclosure Statement complied with the rules at the time it was filed and the attached references merely replace material that has apparently been lost by the PTO.

The Rejection on the Prior Art:

Section 8 of the Office Action rejects some of the claims for anticipation by a patent 7,180,889 to Kung et al, and section 11 rejects the rest of the claims for obviousness on the basis of the same patent. The Kung et al patent will hereafter be called simply "Kung" for the sake of convenient discussion. The rejections are respectfully traversed for the reasons discussed below.

The Kung reference is directed to a packetized telephone system that includes a broadband residential gateway (BRG) which provides versatile handling of incoming calls, as shown in Figures 8 and 9 of the reference. Figure 7 of the reference shows the BRG connected to a plurality of phones.

In contrast to Kung, a single communication terminal of the type disclosed in the present application can serve a plurality of users.

As was mentioned earlier, independent claim 9 now recites "a speech output unit to announce, in plain speech, that the designated user has an incoming call if the designated user is available to answer the call, the announcement identifying the designated user by name." Independent claims 15 and 18 now include the same limitation. Kung does not disclose such a speech output unit. Furthermore, an ordinarily skilled person who wanted to improve some aspect of Kung's arrangement would have no incentive to add the speech output unit of the independent claims, since audio output is directed to the individual telephones of the different users.

Independent claim 20 is similar to claim 9 (in its original form), except the preamble of claim 20 expressly states that the communication terminal can be used by a plurality of users. Since Kung's users need their own telephones, it is respectfully submitted that the invention of claim 20 is patentable over the reference.

The remaining claims depend from the independent claims discussed above and recite additional limitations to further define the invention, so they are automatically patentable along with their independent claims and need not be further discussed. Nevertheless, new dependent claim 24 will now be briefly addressed.

Claim 24 adds a "speech output unit" to what was recited in new claim 20, and it is respectfully submitted that Kung would not have suggested this to an ordinarily skilled person for the reasons previously discussed. In addition, claim 24 recites "a housing for the memory, processor, and speech output unit." Since the BRG and personal computer shown in Kung's Figure 7 are physically separated from the telephones, which have the audio transducers needed for voice communication, it is respectfully submitted that an ordinarily skilled person would not have had an incentive to use a single housing for an audio transducer and elements in the BRG or personal computer.

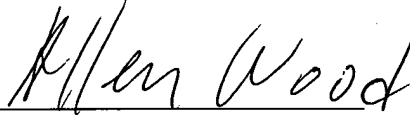
Conclusion:

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance. Reconsideration of the application is therefore respectfully requested.

It is noted that this application has now been amended to include four independent claims. Accordingly, an additional claim fee of \$210 is included in a remittance that is being submitted concurrently.

Finally, it is noted for the record that the published version of this application (number 2004/0179661) includes claims that were cancelled by the Preliminary Amendment filed on March 24, 2004 and fails to include the claims that were added.

Respectfully submitted,

A handwritten signature in cursive script that reads "Allen Wood". The signature is written in dark ink and is positioned above a horizontal line.

Allen Wood
Registration No. 28,134
Rabin & Berdo, P.C.
Customer No. 23995
(202) 326-0222 (telephone)
(202) 408-0924 (facsimile)

AW/ng